

REMARKS

The following remarks are fully and completely responsive to the Office Action dated December 13, 2002. Claims 1-15 are pending in this application. In the outstanding Office Action claims 1-15 were rejected under 35 USC §103(a). No new matter has been entered. Claims 1-15 are presented for consideration.

35 USC §103(a)

Claims 1-15 were rejected under 35 USC §103(a) as being unpatentable over Hirakawa et al. (U.S. Patent No. 5,664,126) in view of DeLorme et al. (U.S. Patent No. 5,559,707) and further in view of Dunworth et al. (U.S. Patent No. 5,930,474). In making this rejection, the Office Action asserts that it would be obvious to one of ordinary skill in the art to combine these three references. The Office Action also asserts that the combination of these three references teach and/or suggest each and every element of the claimed invention. Applicant's request reconsideration of this rejection.

Claim 1 recites a system for transmitting and receiving electronic mail. This system includes a text input means for entering a text of the electronic mail to be transmitted. An extracting means extracts a character string to specify a place from the text inputted by the text input means. An adding means adds information to the electronic mail. The information added corresponds to the place specified by the extracted character string. A text display means displays the text in the electronic mail.

A map display means displays map information indicating the specified place corresponding to the information added to the electronic mail.

Hirakawa teaches a human interface system for communicating between network users. Fig. 1 illustrates a plurality of computers 100 connected in a network. Fig. 2 illustrates an example of one of these computers. Each computer includes an input section 120 that may be formed from a keyboard and/or a mouse with which the user enters characters or commands. A display section 110, which may be a display unit, provides for displaying information including the text of e-mail. A communication section 130 connects each computer to the network. A control section 160 connects the input section 120, the display section 110 and the communication section 130.

Claim 1 recites, in part, an extracting means for extracting a character string to specify a place from the text input by the text input means. This claim element is a means-plus-function claim element under 35 U.S.C. §112, sixth paragraph. Accordingly, a proper prior art rejection must teach the function recited in the claim and must teach the same or equivalent structure disclosed in the present specification to accomplish the recited function. Therefore, the prior art must teach the function of "extracting a character string to specify a place from the text input by the text input means."

The Office Action asserts that Hirakawa at column 2, line 55 teaches an extracting means for extracting a character string to specify a place from the text input by the text input means. This section of Hirakawa, however, teaches that it was well-known in the art to retrieve information on a desired function from an on-line user manual by specifying a particular keyword. The user would enter a keyword and

information on the keyword/desired function would be retrieved using full-text searching/retrieving techniques. Thus, Hirakawa teaches the function of searching a document or documents for a keyword.

The system of Hirakawa uses key words to extract and recognize “urgency” information from the text of the electronic mail message. This “urgency” information represents how quickly or promptly a sender would like the mail receiver to take action. Accordingly, Hirakawa only teaches extracting “urgency” information from the text of the e-mail. Hirakawa, however, does not teach extracting place information (for example, the address of the sender as illustrated in Fig. 41) from the text or the email and then using the place information to display a map to the mail receiver.

Hirakawa provides examples the keywords used in this full-text searching/retrieving technique at column 29, lines 50-54. These keywords include: emergency, urgency, by, if possible, be punctual for, seem, and appear. None of these key words, however, relate to the function of extracting a character string to specify a place from the text input by the text input means. Thus, Hirakawa fails to teach the function of extracting a character string to specify a place from the text input by the text input means.

Claim 1 also recites, in part, an adding means for adding information to the electronic mail, the information corresponding to the place specified by the extracted character string. This claim element is a means-plus-function claim element under 35 U.S.C. §112, sixth paragraph. Accordingly, a proper prior art rejection must teach the function recited in the claim and must teach the same or equivalent structure disclosed in the present specification to accomplish the recited function. Therefore, the prior art

must teach the function of "adding information to the electronic mail, the information corresponding to the place specified by the extracted character string".

The Office Action alleges that Hirakawa at column 33, lines 34-42 teaches an adding means for adding information to the electronic mail, the information corresponding to the place specified by the extracted character string. This section of Hirakawa, however, teaches determining the degree of importance of the received message for the called party on the basis of urgency information added to the message by the calling party degree of urgency judging unit 520 and the state of the called party obtained from the called party's state judging unit 550. Thus, Hirakawa teaches the function of adding urgency information to a message.

Adding urgency information to a message, however, is a different function than adding information corresponding to the place specified by the extracted character string. Consequently, Hirakawa fails to teach the function of adding information to the electronic mail, the information corresponding to the place specified by the extracted character string.

The Office Action admits that Hirakawa fails to explicitly teach a system specifying a place and a map display means. The Office Action cites DeLorme as teaching the use of a map display for showing map information of a specified place. The Office Action asserts that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the map navigation feature of DeLorme with the system of Hirakawa so that map information could be transmitted and received. Applicant disagrees.

DeLorme simply displays a map specified as requested by a user and discloses a general map display device. DeLorme, however, does not display map information transmitted from another user. Thus, there is no motivation to combine DeLorme with Hirakawa.

DeLorme teaches a computer aided routing system. The system determines a travel route between a user selected origin and destination following user selected waypoints. The computer aided routing system database includes travel information obtained from a range of multimedia sources about transportation routes, waypoints and points of interest selected by the user along the travel route.

DeLorme teaches displaying maps with user selected waypoints. Additionally, this reference may calculate an optimum route based on the user selected waypoint list.

DeLorme also teaches extracting a street address stored in a database as a waypoint input. Thus, DeLorme teaches the function of extracting an address from a database and the function of using the extracted address as a waypoint. These functions, however, are different from the function of extracting a character string to specify a place from the text input by the text input means recited by the present claims.

Claim 1 recites, in part, a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail. This claim element is a means-plus-function claim element under 35 U.S.C. §112, sixth paragraph. Accordingly, a proper prior art rejection must teach the function recited in the claim and must teach the same or equivalent structure disclosed in the present specification to accomplish the recited function. Therefore, the prior art must teach the

function of “displaying map information indicating the specified place corresponding to the information added to the electronic mail”.

The Office Action asserts that DeLorme at column 35, lines 11-44 teaches using a map display for showing map information of a specified place. This section of DeLorme , however, teaches that the user must select the information to be displayed. Thus, the user selects what he wants to see. Accordingly, DeLorme teaches the function of displaying map information indicating the specified places corresponding to the map user’s selected or entered information.

Displaying map information corresponding to the map users selected or entered information, however, is a different function than displaying map information indicating the specified place corresponding to the information added to the electronic mail. Consequently, even if DeLorme were combined with Hirakama, Applicant maintains that it would not be obvious to combine these two references, DeLorme fails to teach the function of displaying map information indicating the specified place corresponding to the information added to the electronic mail.

The Office Action admits that DeLorme and Hirakawa fail to explicitly teach and/or suggest launching a map program for a different user. The Office Action cites Dunworth as correcting this deficiency in the combination of Hirakawa and DeLorme.

Dunworth teaches an Internet organizer for accessing geographically and topically based information. Therefore, a user may initiate a regional geographic search from a personal computer or other terminal connected to the Internet.

Applicants have carefully reviewed Dunworth, and did not find any teaching and/or suggestion of launching a map program for a different user. In fact, the Office Action fails

to assert or even identify where Dunworth teaches launching a map program for a different user. Accordingly, Dunworth fails to teach launching a map program for a different user. Accordingly, Dunworth fails to correct the deficiency noted in the Office Action in the combination of DeLorme and Hirakawa, Applicant continues to maintain that it would not be obvious to combine these two references.

Claim 1 recites, in part, a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail. This claim element is a means-plus-function claim element under 35 U.S.C. § 112, sixth paragraph. Accordingly, a proper prior art rejection must teach and function recited in the claim and must teach the same or equivalent structure disclosed in the present specification to accomplish the recited function. Therefore, the prior art must teach the function of “displaying map information indicating the specified place corresponding to the information added to the electronic mail”.

The Office Action also fails to assert that Dunworth teaches or identifies any particular portion of Dunworth that discloses the function of displaying map information indicating the specified place corresponding to the information added to the electronic mail. Dunworth, however, teaches the function of displaying geographically based information requested by the user.

Displaying geographically based information requested by the user, however, is a different function than displaying map information indicating the specified place corresponding to the information added to the electronic mail. Consequently, Dunworth fails to teach the function of displaying map information indicating the specified place corresponding to the information added to the electronic mail.

Applicant maintains that it would not be obvious to combine DeLorme with either Hirakawa or Dunworth. However even if these references were combined, the combination of Hirakawa, DeLorme and Dunworth fail to teach each and every element of the claimed invention. Specifically, these three references fail to teach the function of extracting a character string specifying a place from text inputted by the text input means. Therefore, these references fail to teach and/or suggest an extracting means for extracting a character string specifying a place from the text inputted by the text input means. These references also fail to teach the function of adding information to the electronic mail the information corresponding to the place specified by the extracted character string. Therefore, these references fail to teach and/or suggest an adding means for adding information to the electronic mail, the information corresponding to the place specified by the extracted character string. These references also fail to teach the function of displaying map information indicating the specified place corresponding to the information added to the electronic mail. Therefore, these references fail to teach and/or suggest a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-15 under 35 USC §103(a).

New Claim

Applicants have added new claim 16 to claim additional features of the present invention. This claim is allowable for at least the reasons discussed above.

Conclusion

Applicants' amendments and remarks have overcome the rejections set forth in the Office Action dated December 13, 2002. Specifically, Applicants' remarks have distinguished the claimed invention from the cited prior art and thus overcome the rejection of claims 1-16 under 35 USC §103(a). New claim 16 depends from claim 2. Consequently, claims 1-16 are in condition for allowance. Therefore, Applicants respectfully request reconsideration and allowance of claims 1-16.

Applicants submit that the application is now in condition for allowance. If the Examiner believes that the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned Attorney by telephone, if it is believed that such contact will expedite the prosecution of the application.

The Commissioner is authorized to charge payment of any additional which may be required with respect to this paper to Deposit Account No. 01-2300, making reference to Attorney Docket No. 107439-08005.

Respectfully submitted,



Rustan J. Hill
Registration No. 37,351

Customer No. 004372
ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810
RJH